

REMARKS

Claims 1-51 were pending on the October 16, 2008, mailing date of the final Office Action. Claims 1-3, 6-11, 18-20, 23-28, 31, 35-37, 40-45, and 50 are being amended. Support for the claim amendments can be found in the specification at least in paragraphs [0025] – [0030]. Claims 1, 18, and 35 are the independent claims. Reconsideration of the action and further examination are respectfully requested in light of the foregoing amendments and the following remarks.

Interview Summary

The applicants thank Examiner Brandenburg for the courtesy of a telephonic interview on December 16, 2008. During the interview, the features of claim 1 were discussed in the context of proposed amendments. While no agreement was reached, all parties agreed that the interview aided the mutual understanding of the application and references, and generally advanced prosecution.

Objections

Claims 24, 32, 36, 45, and 50 were objected to for minor informalities. Claims 24, 32, 36, 45, and 50 have been amended to correct the noted informalities. Applicants respectfully request withdrawal of the objections.

§ 103 Rejections

Claims 1-12, 14-15, 18-29, 31-32, 35-46 and 48-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0146939 (“Petropoulos”). Claims 13, 16, 30, 33, 47, and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petropoulos in view of U.S. Publication No. 2002/0165767 (“Ogura”). Claims 17, 34, and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petropoulos in view of Ogura as applied to claims 13, 16, 30, 33, 47 and 50 above, in further in view of U.S. Publication No. 2003/0032677 (“Morgenthaler”). Applicants respectfully traverse these rejections.

Independent claim 1 recites “delivering a first electronic document including an electronic advertisement in a compact display format, wherein the electronic advertisement can

be transitioned from the compact display format into an expanded display format upon a first user selection of an expansion icon associated with the electronic advertisement . . . receiving a second user selection of one of the one or more menu options **after the electronic advertisement has been transitioned from the compact display format to the expanded display format in the first electronic document.**" The relied upon portions of Petropoulos fail to teach or suggest these claim features.

Petropoulos is directed to a system that displays preview information when a user navigates a pointing device over pre-designated areas of a search result page. *See* Abstract. Various results to a search are displayed on a web page along with a preview icon that is associated with the search result that shows a preview of each search result. *See* [0042]. The user is shown preview information when the mouse pointer navigates or passes over a defined area. *See id.* The preview information may be displayed in a frame opened proximate to the time of the mouse-over and endures approximately until the mouse over ends or the user exercises a commit or control. *See id.* The preview information can be an advertisement. *See* [0032].

As an initial matter, a search result displayed in the Petropoulos system is not "an electronic advertisement in a compact display format," as recited in claim 1 because Petropoulos' search result is not an advertisement. Petropoulos describes that the preview information can include an advertisement but does not teach or suggest that the search result displayed is an advertisement.

Petropoulos describes allowing a user to see a preview of the search result. However, Applicant respectfully asserts that Petrapoulos' search result and associated preview web page is not the same as Applicant's claimed electronic advertisement in a compacted display format and expanded display format. The Applicants respectfully assert that the relied upon portions of Petropoulos never transitions any advertisement from a compact display format to an expanded display format. The relied upon portions merely display preview information proximate to the associated search result. Even if the search result was an advertisement, the search result is never transitioned into the preview information. The Applicants respectfully assert that displaying preview information proximate to a search result is not a teaching of an advertisement that "can be transitioned," as recited in claim 1. Therefore, Petropoulos does not teach or

suggest "wherein the electronic advertisement can be transitioned from the compact display format into an expanded display format upon a first user selection of an expansion icon associated with the electronic advertisement."

Therefore, the relied upon portions of Petropoulos fail to teach or suggest at least "delivering a first electronic document including an electronic advertisement in a compact display format, wherein the electronic advertisement can be transitioned from the compact display format into an expanded display format upon a first user selection of an expansion icon associated with the electronic advertisement . . . receiving a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format to the expanded display format in the first electronic document."

The relied upon portions of Ogura and Morgenthaler also do not teach or suggest the claimed subject matter missing from Petropoulos namely "delivering a first electronic document including an electronic advertisement in a compact display format, wherein the electronic advertisement can be transitioned from the compact display format into an expanded display format upon a first user selection of an expansion icon associated with the electronic advertisement . . . receiving a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format to the expanded display format in the first electronic document."

Accordingly, the relied upon portions of Petropoulos, Ogura, and Morgenthaler taken alone or in combination, do not teach or suggest each and every element of claim 1, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons. Claims 2-17 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 18 is directed to an apparatus that includes an electronic advertisement output means for delivering a first electronic document including an electronic advertisement in a compact display format, wherein the electronic advertisement can be transitioned from the compact display format into an expanded display format upon a first user selection of an expansion icon associated with the electronic advertisement, the expanded display format comprising one or more menu options and a reference to a network location for retrieving

specified content associated with each menu option; selection receiving means for receiving a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format to the expanded display format. Claim 18 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 19-34 depend from claim 18 and are allowable for at least the same reasons set forth above with respect to claim 18.

Claim 35 is directed to an apparatus including an electronic advertisement output system for delivering a first electronic document including an electronic advertisement in a compact display format, wherein the electronic advertisement can be transitioned from the compact display format into an expanded display format upon a first user selection of an expansion icon associated with the electronic advertisement, the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and a selection receiving module that receives a second user selection of one of the one or more menu options after the electronic advertisement has been transitioned from the compact display format to the expanded display format. Claim 35 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 36-47 depend from claim 35 and are allowable for at least the same reasons set forth above with respect to claim 35.

Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

Please apply any charges not otherwise paid or any credits to deposit account 06 1050.

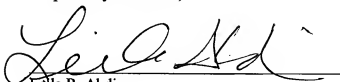
Applicant : Koningstein
Serial No. : 10/748,681
Filed : December 31, 2003
Page : 15 of 15

Attorney's Docket No.: 16113-0639001/ GP-223-00-US

Respectfully submitted,

Date:

1/8/08

A handwritten signature in dark ink, appearing to read 'Lella R. Abdi', written over a horizontal line.

Lella R. Abdi

Reg. No. 52,399

Customer No. 26192
Fish & Richardson P.C.
Telephone: (404) 892-5005
Facsimile: (877) 769-7945

12081649.doc